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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,322	09/04/2003	Sujeet Kumar	2950.15US03	5849
62274	7590	08/21/2006	EXAMINER	
DARDI & ASSOCIATES, PLLC 220 S. 6TH ST. SUITE 2000, U.S. BANK PLAZA MINNEAPOLIS, MN 55402			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/655,322

**Applicant(s)**

KUMAR ET AL.

**Examiner**

Cam N. Nguyen

**Art Unit**

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/02/06 (an amendment/response) & T.D.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Response to Amendment**

1. Applicants' amendment and remarks, filed June 02, 2006, has been made of record and entered. Claim 20 has been canceled.

Claims 1-19 & 21 are currently pending and under consideration.

### **Claim Objections**

2. Claims 2-3, 5, 11-13, 19, & 21 are objected to because of the following informalities:
  - A. In claim 2, line 1, "particle" should be changed to --particles--.
  - B. In claim 3, line 1, "particle" should be changed to --particles--.
  - C. In claim 5, line 1, "effectively" should be deleted.
  - D. In claim 11, line 2, "effectively" should be deleted.
  - E. In claim 12, line 1, "particle" should be changed to --particles--.
  - F. In claim 13, line 1, "particle" should be changed to --particles--.
  - G. In claim 19, line 1, "effectively" should be deleted.
  - H. In claim 21, line 2, "with" should be changed to --having--.

Appropriate correction is required.

### **Claim Rejections - 35 USC § 112 (Second Paragraph)**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites “wherein the particles comprise lithium metal oxides having a structure selected from...”, but the “ $\lambda$ -MnO<sub>2</sub>” in the group listed is not a lithium metal oxide or it does not contain lithium in the structure. Thus, it renders the claim vague and indefinite.

### **Double Patenting**

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5, 8-13, & 16-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of ***U.S. Patent No. 6,225,007*** B1 “hereinafter Pat ‘007”. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

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It is considered that the “multiple metal oxide” of the instant claims 1 & 11 encompasses the “vanadium metal oxide” disclosed in the Pat ‘007. Also, it is considered both the instant claimed particles product and the particles product disclosed in the Pat ‘007 are the same in view of the “vanadium” metal component being claimed in the dependent claims 8 & 16.

Applicants urged, that “under the patent term rules currently in place, an earlier priority date application should not be rejected for obviousness-type double patenting over a later filed patent....” (applicants response on page 5, last paragraph). This is noted, but not found persuasive because it is not true. The purpose of the ODP rejection is to keep the applications or patents commonly assigned.

It is considered the rejection made is still application, therefore maintained.

7. Claims 1-5, 9-13, & 17-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-20 of **U.S. Patent No. 6,387,531 B1** (hereinafter Bi ‘531). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The claimed collection of particles do not appear to be patentable distinguishing from the collection of particles disclosed by Bi ‘531.

8. Claims 1-5, 8-9, 11-13, 16-17, & 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of **U.S. Patent No. 6,106,798** (hereinafter Kambe ‘798). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

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The claimed collection of particles do not appear to be patentable distinguishing from the collection of particles disclosed by Kambe '798.

9. Claims 1-6, 9-14, 17-19, & 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of *U.S. Patent No. 6,506,493 B1* (hereinafter Kumar '493). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The claimed collection of particles do not appear to be patentable distinguishing from the collection of particles disclosed by Kumar '493.

10. Claims 1-5, 10-13, & 18-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of *U.S. Patent No. 6,726,990 B1* (hereinafter Kumar '990). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The claimed collection of particles do not appear to be patentable distinguishing from the collection of particles disclosed by Kumar '990.

**Terminal Disclaimer**

11. The terminal disclaimer filed on June 15, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of *US Pat. 6,136,287* has been reviewed and is accepted. The terminal disclaimer has been recorded.

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**Response to Applicants' Arguments**

12. Applicants' amendment and response filed on June 02, 2006 has been fully reconsidered, but not deemed persuasive in view of the new ground of rejection(s) and/or objection(s) above.

**Conclusion**

13. Claims 1-19 & 21 are pending. Claims 1-19 & 21 are rejected. No claims are allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *cnn*  
August 16, 2006

*Cam Nguyen*  
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